

REMARKS

I. Status of Claims

Prior to entry of this paper, **Claims 1-30** were pending. In the Advisory Action issued April 20, 2009, the previous response was entered and Claims 1-30 were rejected. In this paper, Claims 1, 12, 21, and 30 are amended; no claims are cancelled or added. Claims 1-30 are currently pending. No new matter is added by way of this amendment. For at least the following reasons, applicants' representative respectfully submits that each of the presently pending claims is in condition for allowance.

II. Claim Rejections - 35 U.S.C. § 112

Claims 1-30 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In presenting the grounds of rejection, the final Office Action, at page 3, section 6, states, "*As per claims 1, 12, 21, and 30, the claim limitation is not clearly explained whether the client system or the message system, i.e. the sender server or the sender MTA, performs the disablement function...*"). The applicants' representative respectfully disagrees with this statement and rejection for a number of reasons.

First, it is noted that the rejected claims, including as they are amended herein, do not recite a "sender server" or a "sender MTA". Though not the focus of the above rejection, the applicant's representative disagrees with this implicit characterization of claim elements and reserves the right to further refute this association in subsequent responses.

Further, it is not necessary for the requested explanation of 'which system performs disablement' to be recited in the rejected claims in order for the inventions therein to be distinctly claimed, including as is required under 35 U.S.C. § 112, 2nd paragraph. For example, even without such an 'explanation', the Office Action was able to name at least two systems that may be involved with such a function. Limiting the cited function to either such system, as proposed in the explanation of the rejection, would unduly and unnecessarily restrict the scope of the amended

independent claims. More importantly, such an explanation does not appear to be necessary to overcome the prior art of record.

Moreover, it is respectfully submitted that the phrase “*performs the disablement function*”, as provided in the grounds of rejection is unclear. Particularly, the scope of the term “*function*” in this rejection is unclear with regard to how it is intended to relate to the steps and limitations that are positively recited in the rejected claims. At least so far as amended independent Claims 1, 12, 21, and 30 respectively recite “*disabling*” or “*enabling a disablement of the client's outbound message usage*”, it is respectfully submitted that these claims, as well as the claims that depend therefrom, sufficiently and distinctly claim the subject matter as is necessary to inform public of the boundaries for which protection is sought (See MPEP §2173.02).

Accordingly, withdrawal of the rejections under 35 U.S.C. § 112, 2nd paragraph, is respectfully requested.

III. Claim Rejections - 35 U.S.C. § 103

Claims 1-3, 5, 7, 9-14, 16, 18-23, 25 and 27-30 were rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al., U.S. Patent No. 7,380,126 (hereinafter “Logan”) in view of Rhodes, U.S. Patent Publication No. 2003/0220978 (hereinafter “Rhodes”) in view of Bandini et al., U.S. Patent Publication No. 2002/0169954 (hereinafter “Bandini”).

With this paper, independent claims have been amended to further clarify the grounds of distinction, and thus, patentability, between the prior art of record and the inventions respectively claimed therein.

For example, independent **Claim 1**, as amended, at least recites:

disabling an operable ability of the client to initially send the composed message to the messaging system for sending to each recipient

Support for this amendment can be found throughout the application as originally filed, including on page 3, lines 13-20; page 6, lines 22-24; page 9, lines 16-24; and page 10, lines 13-18 of the specification. Particularly, at least the term “initiated” is noted line 17 of page 9 of the specification as originally filed.

Rather than the above limitation, Logan and Rhodes appear to merely disclose filtering or challenging a message once it has been received at a recipient's location or mail server (see col. 1, lines 61-65 and col. 4, lines 22-33 of Logan and para. [0031, 0034] of Rhodes). As previously noted, these disclosures of Logan and Rhodes do not disclose disabling a “*client's outbound message usage*”, much less the limitations that are further claimed in amended independent Claim 1. The most recent final Office Action, at page 5, lines 8-13, appears to support this position.

However, the disclosure of Bandini does not cure this deficiency. Instead, Bandini appears to somewhat disclose an email firewall 105 or intermediate e-mail relay that may perform operations “in response to a received message” (see para. [0043] of Bandini)(emphasis added). That is, the operations somewhat disclosed in Figures 6(a) and 6(b) of Bandini are still performed after the email message has already been received at the firewall or relay device 202 (see para. [0024, 0029] of Bandini). In fact, the invention of Bandini appears to specifically rely on the fact that email messages are “originating in... a computer network” (see para. [0007], lines 1-3 of Bandini).

Clearly, operating on messages that are already “originating”, as arguably disclosed by Bandini, does not suggest “*disabling*” an operable ability of the client to “*initially send the composed message*” as further claimed in amended independent Claim 1. That is, determining whether a firewall itself performs an alternative action after a message has been received, as arguably disclosed in Bandini (see para. [0037, 0050]), does not suggest “*disabling*” an ability of the “*client*”, much less “*an operable ability of the client to initially send the composed message*” as is further claimed in amended independent Claim 1. Moreover, determining whether the message should “continue”, as noted in the Advisory Action, simply does not suggest disabling a first instance or attempt to send the message, including as it is further presented in amended independent Claim 1.

The Advisory Action further notes that Bandini appears to disclose filtering messages according to “certain hours of the day” (see Continuation Sheet of Advisory Action). However, this ‘filtering’ function is provided by an access manager 218 in the system of Bandini, which is still applied to a message after the relay module 202 has already received the message (see lines 4-10 of para. [0029]; para. [0031]; and Figure 2, each of Bandini). Thus, these disclosures, including the

policies of access manager 218 and the steps of Figure 7 of Bandini, also do not suggest “*an operable ability of the client to initially send*” for at least similar reasons to those discussed above.

For at least these reasons, withdrawal of the previous rejection under 35 U.S.C. § 103(a) is respectfully requested.

With this paper, independent **Claims 12, 21, and 30** have been amended to include limitations that are similar, albeit different, to that discussed above with regard to amended independent Claim 1. For at least the same reasons, the combination of Logan, Rhodes, and Bandini, does not suggest these limitations of these claims, especially when they are considered as a whole. Withdrawal of the previous rejection under 35 U.S.C. § 103(a) of these claims is therefore also respectfully requested.

So far as **Claims 2-3, 5, 7, 9-11, 13-14, 16, 18-20, 22-23, 25 and 27-29** depend respectively from amended independent base Claims 1, 12, and 21, these claims are not rendered obvious by the combination of Logan, Rhodes, and Bandini for at least the same reasons as amended independent Claim 1. Withdrawal of the rejections of these claims under 35 U.S.C. § 103(a) is therefore respectfully requested for at least these same reasons.

Claims 6, 8, 15, 17, 24 and 26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Logan, in view of Rhodes, Bandini and further in view of Wilson, U.S. Patent Publication No. 2004/0015554 (hereinafter “Wilson”). **Claim 4** was rejected under 35 U.S.C. 103(a) as being unpatentable over Logan, in view of Rhodes, Bandini and further in view of Burrows et al., U.S. Patent No. 7,149,801 (hereinafter “Burrows”).

However, so far as **Claims 4, 6, 8, 15, 17, 24 and 26** depend respectively from amended independent base Claims 1, 12, and 21, these claims are not rendered obvious by the combination of Logan, Rhodes, and Bandini for at least the same reasons as amended independent Claim 1. None of the other references address the deficiencies of Logan, Rhodes, and Bandini noted above. Withdrawal of the rejections of these claims under 35 U.S.C. § 103(a) is therefore respectfully requested for at least these same reasons.

CONCLUSION

In view of the above amendment, applicant's representative believes the pending application is in condition for allowance.

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Respectfully submitted,

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